

## **SUMMARY**

The following Remarks are responsive to the Office Action dated June 19, 2006. In the Office Action, claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of “Switchable Privacy Glass.” Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of “Switchable Privacy Glass.” Claims 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of “Switchable Privacy Glass.” Upon entry of this Response, claims 1-20 remain pending in this application. Entry and consideration of this Response are respectfully requested.

### **Response to Rejections Under 35 U.S.C. § 103(a):**

In the Office Action, claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of “Switchable Privacy Glass.” Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of “Switchable Privacy Glass.” Claims 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/35242 in view of “Switchable Privacy Glass.” Applicants traverse these rejections.

The basic test for non-obviousness is whether a claimed invention, at the time it was made, would have been obvious to a person having ordinary skill in the art to which the subject matter of the invention pertains, in view of the prior art. If so, the claimed invention is obvious and not patentable. If not, however, the claimed invention is non-obvious and patentable. The United States Supreme Court in *Graham v. John Deere & Co.*, 383 U.S. 1 (1966), set forth the following factual inquiries to be made when determining whether a claimed invention would have been obvious to an ordinarily skilled artisan:

- (1) determine the scope and content of the prior art;
- (2) ascertain the differences between the prior art and the claims at issue;
- (3) resolve the level of ordinary skill in the pertinent art.

In determining the scope and content of the prior art, the Examiner must first consider the inventor's field of endeavor and the nature of the problem on which the inventor was working. Once this has been established, the Examiner must select, for purposes of combining and comparing with the claims at issue, prior art references from analogous arts; that is, within the inventor's field of endeavor and/or reasonably pertinent to the problem being addressed. See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 1071 (Fed. Cir. 1994). In selecting and combining references, hindsight must be avoided at all costs.

The second factor of *Graham* requires that an examiner ascertain the differences between cited prior art references and the claims at issue. In the instance case, as discussed in detail above and below, the difference here is that the references fail to disclose the claimed invention.

To resolve the level of ordinary skill in the pertinent art, as required by the third *Graham* factor, an Examiner must place herself in the shoes of a person of ordinary skill in the art at the time the invention was made. The hypothetical person skilled in the art is one who thinks along lines of conventional wisdom in the art and one who does not have the benefit of hindsight.

In order to establish a prima facie case of obviousness when proposing to combine the teachings of two or more references, it is necessary for an Examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art references, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led or motivated to combine the teachings of the references in the proposed manner, and that the proposed combination teaches the claimed invention. *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (Bd. Pat. App. & Interf. 1993); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). A legal conclusion of obviousness by an Examiner must be supported by facts or it cannot stand. See *Graham*.

A rejection based on 35 U.S.C. § 103(a) therefore clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art or “viewed after the event.” *Goodyear Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). The proper inquiry is whether bringing references together would have been obvious when the invention was made, and not whether one of ordinary skill, having the invention before him, would find it obvious, through hindsight, to construct the invention from the teachings of the references. An Examiner cannot establish obviousness by locating references that describe various aspects of a claimed invention without also providing evidence of the motivating force that would have lead one skilled in the art, at the time the invention was made and without hindsight, to combine the teachings of the references as the Examiner proposes.

In the present case, the Examiner has not established a prima facie case of obviousness necessary to support the rejections under 103(a). The Examiner states that:

WO 00135242 discloses the use of a window unit (21,24,26,27) (similar to those shown in figures 7-11 and 12) including a window frame (F) defining a perimeter, a window (20,25,28) located within the frame (F) perimeter, see attached, and a speaker element (5) disposed within the window unit (21,24,26,27). WO 00135242 discloses the basic claimed invention except for window explicitly including a display image and except for the window being able to transform from transparent to increased opacity. "Switchable Privacy Glass" teaches that it is known in the art to not only form a window or glass pane with a display image and source, as in the top figure on page 2 of the brochure submitted 7/12/05, but that the window or glass pane is also capable of transmission from a transparent state to an increase opacity state through the use of liquid crystals and electric current as the image display source. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the window unit of WO 00135242 with the transparent opaque transmittable window glass pane of "Switchable Privacy Glass" in order to control the vision therethrough both during day and night hours. Providing a window unit with the ability to be opaque allows sunlight to shine through during the day and permits privacy during evening hours without the hassle of curtains, blinds, or other assemblies used to cover windows.

However, neither WO 00/35242 nor “Switchable Privacy Glass” provide a motivation to combine their disparate teachings without using the present application’s teachings, which is specifically forbidden by hindsight.

WO 00/35242 provides a loudspeaker that vibrates a pane of glass to produce acoustic output. Every window shown in the figures of WO 00/35242 includes a vibratory speaker element. Even if a motivation to replace a window of WO 00/35242 with a “Switchable Privacy Glass” window (no such motivation is shown or taught), the combination would yield a switchable window with vibratory exciters. This is nonsensical. One of ordinary skill would not be motivated to create a vibrating glass speaker. Further, one would not be motivated to create a vibratory display pane to display images – since the images would vibrate. Clearly, absent the present invention’s teachings, no motivation exists in these references that would teach or suggest the proposed combination.

Further, the proposed combination of WO 00/35242 with “Switchable Privacy Glass” simply is not properly supported. Specifically, the Examiner has not pointed to any suggestion or motivation to combine these two references. In fact, there is not, and would not have been at the time the invention was made, any motivation to make such a combination. WO 00/35242 teaches only a loudspeaker and fails entirely to teach or suggest a switchable glazed window that is excited by vibration to display an image. “Switchable Privacy Glass” teaches only switchable glazed windows and fails entirely to teach or suggest a speaker system. The Examiner is not allowed to pick elements of disparate teachings to assert that an invention is obvious. Further, such suggestion, especially when made while combining disparate arts, cannot be gleaned from the Applicant’s specification.

For at least the foregoing reasons, the rejections under 35 USC §103(a) are improper and should be withdrawn. The invention is not obvious in view of the prior art, and the pending claims are thus allowable over such art.

### **CONCLUSION**

Claims 1-20 are allowable and a notice to such effect is earnestly solicited. Should the Examiner have any questions or comments regarding the foregoing Response, she is invited and urged to telephone the undersigned attorney.

### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Response under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Date:

9/19/06

Respectfully submitted,



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Docket No.: A202 1460